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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,653	09/30/2003	Marc E. Feinberg	ETH5092	4786

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PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

EXAMINER

POUS, NATALIE R

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/674,653

Applicant(s)

FEINBERG, MARC E.

Examiner

Natalie Pous

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 3, 4, 7, 9, 11, 13, 15 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 6, 8, 10, 12, 14, 16 and 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/16/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species:

Species 1: figure 2 relating to pair of slidable bosses attachment means

Species 2: figure 6 relating to yoke attachment means

The species are independent or distinct because they relate to different technical features. For instance, in species 1, the arms are attached to each other and move by way of the pair of bosses sliding with respect to each other. On the other hand, in species 2, the arms are attached to each other and move by way of pivoting around a yoke.

2. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 2, 19, 20 and 21 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

3. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations

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of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

4. During a telephone conversation with Blossom Loo on 5/16/06 a provisional election was made without traverse to prosecute the invention of species 2, claims 5, 6, 8, 10, 12, 14, 16 and 18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 3, 4, 7, 9, 11, 13, 15 and 17 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1, 2 and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Hasson (US 3926193).

Regarding Claim 1, Hasson teaches a tissue approximation device comprising two elongate arms (18, 26), an attachment means (22) to secure the elongate arms to each other, adhesive pads (12) on at least a portion of the elongate arms to anchor the tissue approximation device to the skin (fig. 1), and a locking means (22) to lock the elongate arms in place relative to each other.

Regarding Claim 2, Hasson teaches the tissue approximation device of claim 1, further having an open and closed position, and when in the closed position (fig. 1), the adhesive pads are (12) are parallel and non-contiguous to each other.

Regarding Claim 19, Hasson teaches the tissue approximation device of claim 1, where the attachment means and the locking means (22) are the same.

Regarding Claim 20, Hasson teaches the tissue approximation device of claim 19, wherein the adhesive pads (12) are located on at least a portion of each of the elongate arms (fig. 1)

Regarding Claim 21, Hasson teaches a method of closing a wound comprising the steps of providing a tissue approximation device comprising two elongate arms (18, 26), an attachment means (22) to secure the arms to each other, adhesive pads (12) on at least a portion of the elongate arms to anchor the tissue approximation device to the skin (fig. 1), and a locking means (36) to lock the elongate arms in place relative to each other; positioning the adhesive pads to the skin on opposed sides of a wound (14); approximating the wound closure by actuating the tissue approximation device in a direction to move the adhesive pads towards each other in a common plane that is generally parallel to the skin tissue (Column 4, proximate lines 10-16); engaging the locking means to assure that the edges surfaces of the wound do not move (Column 4, proximate lines 10-16); applying a wound closure means (22) to the wound; and removing the adhesive pads from the skin tissue (Column 1, proximate line 31).

7. Claims 1, 5, 6, 12, 14 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Fogarty (US 4821719).

Regarding Claim 1, Fogarty teaches a tissue approximation device comprising two elongate arms (10, 12), an attachment means (16) to secure the elongate arms to each other, adhesive pads (30) on at least a portion of the elongate arms capable of anchoring the tissue approximation device to the skin, and a locking means (22, 24) to lock the elongate arms in place relative to each other.

Regarding Claim 5, Fogarty teaches the tissue approximation device of claim 1, wherein the elongate arms form a pair of forceps (14), the attachment means (16) is a yoke on the forceps, and the locking means (22, 24) is a ratchet mechanism on the forceps.

Regarding Claim 6, Fogarty teaches the tissue approximation device of claim 5, wherein the distance between the elongate arms is adjustable by means of ratchet mechanism (22, 24)

Regarding Claim 12, Fogarty teaches the tissue approximation device of claim 5, wherein the adhesive pad has a first surface (30a) and a second surface (55) having a female receiving mechanism that communicates with a male protrusion (52) on the distal end of each of the elongate arms (fig. 5)

Regarding Claim 14, Fogarty teaches the tissue approximation device of claim 5, wherein the adhesive pad has a first adhering surface (38) and a second surface having a male protruding mechanism (48) that communicates with a female receiving mechanism (42) on the distal end of each of the elongate arms (10, 12)

Regarding Claim 16, Fogarty teaches the tissue approximation device of claim 5, wherein the distal end of the elongate arms has a passageway (42) therein such that the adhesive pad (30) communicates with said passageway (48).

Regarding Claim 18, Fogarty teaches the tissue approximation device of claim 5, wherein the adhesive pad has a passageway therein (55), such that the distal end of each of the elongate arms (52) is within said passageway (fig. 5)

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fogarty in view of Agnone (US 3754331). Fogarty teaches all limitations of preceding dependent claims 1 and 5, but fails to disclose wherein the elongate member and pad form a ball and socket connection. Agnone teaches forceps wherein the distal pads

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connect to the elongate members by means of a ball and socket joint in order to allow the pads to move independently of the elongate arms and gain a better grip on the tissue. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Fogarty with a ball and socket joint as taught by Agnone in order to allow the pads to move independently of the elongate arms and gain a better grip on the tissue.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Swindle et al. (US 5891017)

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie Pous whose telephone number is (571) 272-6140. The examiner can normally be reached on Monday-Friday 8:00am-5:30pm, off every 2nd Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NRP
5/19/06


(JACKIE) TAN-UYEN HO
PRIMARY EXAMINER